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10/729,235	12/05/2003	Roger Thomas	P-US-PR 1112	9207

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EXAMINER

SELF, SHELLEY M

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/729,235

Applicant(s)

THOMAS, ROGER

Examiner

Shelley Self

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,11 and 12 is/are rejected.
- 7) ☒ Claim(s) 2,4,6-10,13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/5/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *motor, airflow generator* (clm. 1) and *airflow intersect at an acute angle* (clm. 3) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

The disclosure is objected to because of the following informalities:

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- Page. 7, line 23 the phrase "*body 2 to of*" is confusing and unclear
- Page 7, line 24, the phrase, "*pivotal flap is its*" is confusing and unclear
- Page 8, lines 9, 10 & 25, the phrase "*body to of*" is confusing and unclear

Additionally, the term, "*exhaust aperture*" (clm. 1) does not have sufficient antecedent basis within the specification, such term is not used or defined by the specification.

Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 7-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5-9 of copending Application No. 10/729232. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the presently presented application are merely re-worded from that presented in the co-pending application. For example, claim 1 of the presently presented application and the co-pending application define a planer comprising a shoe, body, cutting drum, motor, cutting blade, airflow generator, conduit and deflector. The

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present application states, the deflector to be "removable", the co-pending application states the deflector to be "connectable to"; Examiner notes that to be connectable, it is also inherently removable, thus the claims of the presently presented application are not patentably distinct from those set forth in the co-pending application, 10/729232.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 3-6, 11, 12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claims 3 and 4, failure to clearly illustrate the intersection of the airflow and debris at an acute angle, renders a clear understanding of the claimed invention difficult.

With regard to claim 11, there is no antecedent basis for the term, "*the biasing means*", additionally, it is not clear how the "*biasing means*" relates to the rest of the positively claimed elements, i.e., the claim fails to set forth the critical interrelationship between the "*biasing means*" and the rest of the claimed structure.

Further, regarding claim 1, the word "means" is preceded by the word(s) "biasing" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is

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impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Examiner suggests, --means for biasing—

Also there is insufficient antecedent basis for, “the axis of pivot” (clm. 12).

Correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 and claims 3 and 5 as best as can be understood are rejected under 35

U.S.C. 102(b) as being anticipated by Bellew et al. (5,463,816). Bellew discloses a planer (10) comprising: a shoe (fig. 5), the shoe defining an aperture (fig. 5); a body mounted on the shoe; the body defining an exhaust aperture (42) and including a wall (48), the wall defining a recess (34); a cutting drum (28) rotatably mounted within the recess (fig. 5), the drum having a periphery and a portion of the periphery of the cutting drum projects through the aperture in the shoe (fig. 5); a motor (24) mounted within the body to rotatably drive the cutting drum (28); a cutting blade (40) mounted on the periphery of the drum and adapted for cutting a work piece when the drum is rotating (fig. 5), the cutting action of the blade causing debris created by the cutting to be ejected from the recess (34); an airflow generator (26) for producing an airflow within the body; a conduit (col. 3, lines 15-20) defined within the body for directing the airflow,

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the conduit in communication with the exhaust aperture and connected to the recess for entraining and removing debris ejected from the recess; and a removable deflector (12) having an inner end and an outer end, the deflector insertable through the exhaust aperture and connectable to the conduit for guiding the air flow and entrained debris from within the body to outside of the body, and wherein the deflector is insertable in a downward slope.

Claim 3 as best as can be understood discloses an expulsion aperture (Examiner notes the directional arrows of fig. 5 as an expulsion aperture) and the conduit is connected to the recess (34) by the expulsion aperture (fig. 5), and the cutting action of the blade (40) causes debris created by the cutting to be ejected from the recess through the expulsion aperture (fig. 5) and into the conduit substantially along a first direction, and the airflow in the conduit is directed within the body to a point below the expulsion aperture and then is directed by the conduit to be blown across the aperture substantially along a second direction and the first direction of the debris and the second direction of the airflow intersect at an acute angle. Examiner notes that the airflow is inherently directed below the cutting drum (28) and then upward (see directional arrows fig. 5) so as to allow the debris to be expelled through the expulsion chamber and subsequently through the deflector (12).

With regard to claim 5, as best as can be understood, because the airflow is recycled via an airflow generator (26), Bellow discloses the conduit directs the airflow over the removable deflector (12) prior to directing the airflow to the point below the expulsion aperture. Examiner notes the airflow to be recycled and flowing in a counter clockwise motion, thus the airflow would be directed over the deflector (12), prior to being recycled to be directed below the expulsion aperture, to direct debris back to the deflector for exhaust.

With regard to claim 6, as best as can be understood, Bellow discloses wherein the removable deflector defines a portion of the conduit where the airflow passes over the deflector.

***Allowable Subject Matter***

Claims 2, 4 and 7-10, 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if any 35 U. S. C, 112 rejection(s) were overcome.

Claims 11 and 12 would be allowable if re-written to correct the 35 U.S.C. rejection(s) based on their dependency of claim 7, indicated as containing allowable subject matter.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose a second exhaust aperture in communication with the first exhaust aperture and the conduit in combination with the rest of the claimed limitations as set forth in claim 2.

Also, the prior art of record does not disclose the conduit divides the airflow into a first part and second part in combination with the rest of the claimed limitations as set forth in claim 4.

Additionally, the prior art of record does not disclose a flap movable from a first and second position in combination with the rest of the claimed limitations as set forth in claim 7.

The prior art of record, Bellow discloses a planer comprising a shoe, body, cutting drum, motor, cutting blade, airflow generator, conduit and deflector. Bellow discloses that as the rotatably driven cutting drum is operated, the blades (40) associated with the drum remove material from a work piece, thereby creating chips or shavings. Bellow discloses that the chips



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and/or shavings are expelled from the planar through an expulsion aperture (see figure 5, Examiner notes the directional arrows), such that the chips are ultimately expelled via deflector and nozzle (12, 56). Bellows discloses the nozzle of the deflector able to be attached to a bag or collection receptacle for the purposes of collecting any debris from the planing operation. Further, Bellow discloses that is it the deflector that is attached to the planar exhaust aperture (figs. 1-3 & 5) via fasteners (66). Bellow does not disclose a *movable flap* or an *additional exhaust aperture* in communication with the conduit and the first exhaust aperture. Further, Bellow fails to disclose or fairly suggest a conduit dividing airflow into a first and second part and the second part passing airflow in a third direction. Accordingly, Bellow fails to anticipate or render obvious the claimed invention as set forth in claims 2, 4 and 7.

Neither the prior art of record, nor any combination thereof discloses the claimed invention as set forth in claims 2, 4 and 7.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIE or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf

May 24, 2005



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